

In the Drawings:

The Examiner objected to Figures 3, 4, and 6 of the drawings. More specifically, the Examiner identified the misspelling of the word “converter”. Replacement sheets for Figures 3A, 3B, 4 and 6 are submitted herewith correcting the typographical error noted by the Examiner.

REMARKS

Claims 1-3, 5-17, 19-29, 31-42, and 44-48 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Double Patenting Rejection:

The Office Action rejected claims 1-3, 5-17, 19-29, 31-42 and 44-48 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent 7,200,668 (“the ‘668 Patent”), and over claims 1-32 of co-pending Application No. 10/090,893 (“the ‘893 Application”). Applicants respectfully traverse these rejections for at least the following reasons.

With regard to each of these references, the Examiner simply asserts that the claims of the of the ‘668 Patent (more specifically, claim 1) and the ‘893 Application (more specifically, claims 1, 10, and 11) contain every element of various ones of the claims of the present application; **however, the Examiner is simply incorrect.** The present claims include limitations directed towards a server configured to plug a converter module into a framework configured to accept one or more pluggable modules, where the converter module is operable to perform various actions for converting documents between a server and a small device. **The claims of the ‘668 Patent and the ‘893 Application do not require these features.** As such, the Examiner is **incorrect** in stating that the claims of these references include all the limitations of the present claims.

Besides these incorrect statements, the Examiner provides no further evidence or reasoning as to how the present claims are anticipated or obvious in light of the claims of these references. Applicants submit that the Examiner has failed to provide a proper *prima facie* rejection of the present claims. According to MPEP 804.II.B.1, “the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection.” This section of the MPEP also states that the same “factual inquires ... that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are employed when making an obviousness-type double patenting analysis.” MPEP 804.II.B.1 also states that the Examiner should list the differences between **each** rejected claim and the claims of the other patent/application, and for **each** difference the Examiner should give the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim is an obvious variation of the invention defined in a claim of the other patent/application. An inaccurate statement regarding the claim limitations of the present application and the ‘668 Patent / ‘893 Application is not a valid reason why a person of ordinary skill in the art would conclude that the invention defined in each claim is an obvious variation of the invention defined in a claim of the other patent/application. Nor has the Examiner specifically addressed **each difference** of **each claim** of the present application compared to the claims of the other applications. Instead, the Examiner improperly lumped all the claims together and did not address each specific difference. The Examiner clearly has not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Applicants respectfully request removal of the double patenting rejection.

Section 102(e) Rejection:

The Office Action rejected claims 1-3, 5-17, 19-29, 31-42 and 44-48 under 35 U.S.C. § 102(e) as being anticipated by Sena et al. (U.S. Patent 7,039,643) (hereinafter “Sena”). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, Sena fails to disclose that the server is further configured to plug a converter module into a framework configured to accept one or more pluggable modules. With respect to this feature, the Examiner cites “transformation module 460” and Figures 7 and 8, modules 420, 450, and 480, without any further explanation. Applicants submit that the mere existence of “modules” (as indicated by the transformation module and the presence of modules 420, 450, and 480 in Figures 7 and 8) does not teach, suggest, *or even hint at* a server which is configured to **plug** a specific converter module **into a framework configured to accept one or more pluggable**

modules. Sena nowhere describes a converter module which is pluggable into a framework for accepting pluggable modules. Many software designs that employ modules are designed such that the modules are not pluggable. There is no evidence that transformation module 460 of Sena is pluggable into a framework as recited in Applicants' claim. The Examiner has failed to provide any evidence that Sena anticipates this feature of claim 1.

Further regarding claim 1, Sena fails to disclose that the converter module is further configured to receive a modified version of the document in the small device format from the small device. With respect to this feature, the Examiner cites "a changed/modified version" and "Figs. 6, 14, steps 1154-1156; col. 8, lines 35-38" without any further explanation. First, Applicants note that the Examiner relied on the "transformation module 460" for the converter module in the limitation described above. However, the transformation module is nowhere described as being configured to receive a modified version of the document in the small device format from the small device. Instead, the transformation module 460 is described in column 9, lines 10-26:

The digital media transformation module 460, takes the two media files 410, 412, breaks them down into low level data components and then converts them to an intermediate format where two or more files can now be integrated. The media files 410, 412 are integrated and converted again into the desired media output file 599.

Thus, the transformation module is used to compile different media files into an integrated file of a desired type. Applicants submit that one of ordinary skill in the art understands that the integration of multiple media files is not the reception of a modified version of the document (which has already been provided to the small device in the small format after conversion by the converter module) from the small device. Instead, the media files are received from a user who desired to generate an integrated media file from multiple media files.

Regarding the Examiner's citation, the portion from column 8 recites:

If the user selects the powerpoint-audio option, in step 1130 the software executes instructions which either adds an audio file or in step 1132 allows the user to record an audio file while the Powerpoint presentation is playing. In step 1134 the system adds any other media files to the

Powerpoint file. In step 1150, the user chooses the “upload” option, which connects the personal computer to system 1000 in step 1152. In step 1154 the software loads the modified file to system 1000, which then places the file in input handler module 1020 in step 1156.

Thus, the cited portion relates to a user providing media files with a Powerpoint presentation for integration into a single media output file. There is absolutely no teaching or suggestion that the transformation module (which the Examiner cites as the converter module) is configured to receive a modified version of the document **in the small device format from the small device**. There is especially no suggestion that the document was originally converted by the transformation module from a server format to a small device format and then provided to the small device. Thus, the Examiner has failed to provide any evidence that Sena anticipates this feature of claim 1.

Additionally, Sena fails to disclose that the converter module is further configured to generate a modified version of the document in the server format from the modified version of the document in the small device format. With respect to this feature, the Examiner relies on Figures 7 and 10 as well as column 4, line 20 – column 5, line 49; column 9, lines 11-26; and column 10, line 51-column 12, line 35, without any explanation. As noted above, Sena nowhere discloses that the transformation module (or any module for that matter) receives a modified version of the document in a small device format from a small device. Accordingly, there can be no teaching in Sena which then generates a modified version of the document in the server format from the modified version of the document in the small device format. However, the Examiner has attempted to address this limitation with the citations listed above. Applicants address them below.

First, Figures 7 and 10 show a general flow of information between modules and devices as described in Sena. The cited Figures have nothing to do with the generation of a modified version of a document in a server format from a modified version of the document in the small device format that was received from the small device. Column 4, line 20 – column 5, line 49 is the summary of the Invention described in Sena. This portion describes how multiple media files may be integrated and provided in an output

format which may be compatible with various devices (e.g., PDAs). There is no teaching or suggestion of a modification of the files in a small device format, a provision of the modified files in the small device format from the small device, or a conversion of the modified document from the small device format to a server format in this section. The cited portion of column 9 relates to the digital transformation module 460 which breaks down media files for integration into a single output media file, which, as argued above, is not the converter module, nor is it configured to perform the actions described in this limitation. Finally, columns 10-12 describe various specific procedures in the integration of multiple media files into a single output media file and has nothing to do with the recited limitation above. Thus, Sena fails to teach this feature of claim 1.

Applicants remind the Examiner that anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As shown above, Sena clearly fails to anticipate Applicants' invention as recited in claim 1 for numerous reasons.

For at least the reasons above, the rejection of claim 1, and those claims dependent therefrom, is not supported by the cited art and removal thereof is respectfully requested. Independent claims 16, 29, and 42 include similar limitations as claim 1, and so the above arguments apply with equal force to claims 16, 29, and 42. Thus, for at least the reasons provided above, the rejection of claims 16, 29, and 42, and those claims dependent therefrom, is not supported by the prior art and removal thereof is respectfully requested.

Additionally, Applicants assert that the rejection of numerous ones of the dependent claims is further unsupported by the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10600/RCK.

Respectfully submitted,

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